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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,959	05/31/2000	Mark Joseph Hamzy	AUS9-2000-0068-US1	2343

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05/10/2004

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EXAMINER

CHANG, JUNGWON

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 05/10/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,959

Applicant(s)

HAMZY ET AL.

Examiner

Jungwon Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-18 are presented for examination.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 13 and 17 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 11 of U.S. Patent No. 6,539,424. Although the conflicting claims are not identical, they are not patentably distinct from each other because both systems comprise substantially the same elements. The difference between Patent No. 6,539,424 and present application is the claimed higher level page and different resource. However, both higher level page and different resource have the same function how to reach to the requested resource

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(i.e., by following links). Changing the name will not serve as a basis for patentability.

Therefore, they are not patentably distinct from each other.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Dutta (US 6,539,424 B1).

6. The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

7. Dutta was cited by applicant dated 9/5/2000 in IDS paper #2.

8. As to claims 13 and 17, Dutta discloses the invention as claimed, including a

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method, in a client data processing system (103, fig. 1), for receiving a resource in response to a request to a server data processing system (col. 1, lines 7-12; col. 2, lines 60-66), comprising:

sending the request (401, fig. 4; col. 2, lines 60-62; col. 5, lines 39-42); and
receiving a different resource (404, fig. 4, i.e., home page, index.html) than the requested resource if the requested resource was a deep hyperlink (col. 6, lines 2-9 and 11-16) wherein the different resource (301, fig. 3; i.e., home page, index.html) has a content combining the requested resource content (312, fig. 3; i.e., requested resource) with at least a portion of another resource content (404, fig. 4; col. 6, lines 3-16) wherein the requested resource (403, fig. 4) can be reached by following links from the another resource content (405-407, fig. 4; col. 6, lines 15-16, 25-28 and 33-38; col. 4, lines 11-15).

9. As to claims 15 and 16, Dutta discloses keeping track of each request made for the at least one prerequisite resource for each requester within a tracking parameter (i.e., cookie; fig. 5; col. 3, lines 4-8; col. 4, lines 42-59; col. 5, lines 26-34).

10. As to claims 1 and 14, Dutta discloses the invention as claimed, including a method, in a server data processing system (101, 102, fig. 1), for servicing a request for a resource requested by client data processing system (col. 1, lines 7-12; col. 2, lines 60-66), comprising:

receiving the request for the resource from a requester (i.e., client) (401, fig. 4;

col. 2, lines 60-62; col. 5, lines 39-42);

determining if the resource requires at least one prerequisite resource (402, fig. 4; col. 4, lines 45-47; col. 2, lines 62-64), and if the at least one prerequisite resource has been previously requested by the requester (col. 5, lines 45-49); and

sending a different resource (404, fig. 4, i.e., home page, index.html) having a content combining the requested resource content (312, fig. 3; i.e., requested resource) and at least a portion of content of at least one prerequisite resource (404, fig. 4; col. 6, lines 3-16) if the requested resource requires a prerequisite resource (402, fig. 4; col. 5, lines 45-49).

11. As to claims 2-5, Dutta discloses keeping track of each request made for the at least one prerequisite resource for each requester within a tracking parameter (i.e., cookie; fig. 5; col. 3, lines 4-8; col. 4, lines 42-59; col. 5, lines 26-34).

12. As to claims 6 and 7, Dutta discloses determining if a previous request has been made by the requester for the prerequisite resource within the tracking parameter (i.e., cookie; fig. 5) if the requested resource requires a prerequisite resource (col. 5, lines 39-49); and sending different resource if any previous request has not been made (col. 5, line 56 – col. 6, line 10).

13. As to claim 8, Dutta discloses determining which at least one resource is the

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at least one prerequisite resource (col. 2, lines 65-66; col. 4, lines 10-23; col. 6, lines 39-44).

14. As to claims 9 and 10, Dutta further discloses modification comprises merging the content of the prerequisite resource with the content of the requested resource (col. 6, lines 39-44; col. 4, lines 10-23; col. 6, lines 6-10 and 39-44; col. 8, lines 8-16).

15. As to claims 11 and 12, Dutta further discloses content of the different resource comprises changing a resolution of the requested resource to a lesser quality (col. 7, lines 4-20, i.e., web publisher can modify the web pages using the program code).

16. As to claim 18, Dutta discloses the invention as claimed in claims 1 and 14. In addition, Dutta discloses a program, having computer readable program code means, on a computer usable medium, for servicing a request for a resource requested by a client data processing system (col. 7, lines 13-20; col. 8, lines 4-16).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:


Rabindranath Dutta, claims of Application No. 09/434,855 disclose a method and system of controlling access to a content producer server.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jungwon Chang whose telephone number is (703)305-9669. The examiner can normally be reached on 9:30-6:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (703)305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jungwon Chang
April 30, 2004


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
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